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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/603,885	06/26/2000	Stephen William Watson Michnick	Oddy 004	2144

7590 07/16/2002
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EXAMINER

PONNALURI, PADMASHRI

ART UNIT PAPER NUMBER

1627

DATE MAILED: 07/16/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/603,885

Applicant(s)
Michnick et al

Examiner
Padmashri Ponnaluri

Art Unit
1627



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-17 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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1. Claims 1-17 are currently pending in this application.

Please Note: In an effort to enhance communication with our customers and reduce processing time, a dedicated Fax machine is in place to receive your responses. The Fax number is 703-308-4315. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Jyothsna Venkat, Ph.D., Supervisory Patent Examiner at jyothsna.venkat@uspto.gov or 703-308-2439. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

Election/Restriction

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1, 3-4 and 9, drawn to a method for identifying an interacting set of molecules, classified in class 435, subclass 6 or class 436, subclass 518.
 - II. Claims 2, 5-6 and 9, drawn to a method for identifying an interacting set of molecules (NOTE: the method steps are different from group I method steps), classified in class 435, subclass 6.
 - III. Claims 7 and 9, drawn to a method of screening multiple panels of molecules against each other to determine the ability of individual panel members to form an interacting set, classified in class 435, subclass 6.

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- IV. Claims 8-9, drawn to a method comprising directly or indirectly introducing different interacting sets into separate cell populations , classified in class 435, subclass 6.
 - V. Claim 10, drawn to a method of preparing an assay system, classified in class 436, subclass 518.
 - VI. Claim 11, drawn to an assay system comprising a first panel of molecules coupled to first fragments of a reporter molecule and a second panel of molecules coupled to the second fragment of said reporter molecule, classified in class 435, subclass 283.1.
 - VII. Claim 12, drawn to a composition comprising at least one compound produced according to claim 10, classified in class 435, subclass 69.7.
 - VIII. Claims 13-16, drawn to a composition comprising one or more interacting sets of molecules as identified by a method, and cells containing the interacting set of molecules, classified in various class and subclass depending on the compound (i.e., if the compound is oligonucleotides in class 536; if the compound is peptide in class 530...).
 - IX. Claim 17, drawn to method comprising directly or indirectly introducing different interacting sets into separate cell populations and identifying an interacting set., classified in class 435, subclass 6.
3. The inventions are distinct, each from the other because of the following reasons:

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4. Inventions of groups I-V, IX are drawn to different methods. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions . The inventions are of groups I-V and IX are all drawn to different methods. The methods are different from each other, use different method steps and the results of the methods are not the same. Thus, restriction between the groups is proper.

5. Inventions of groups VI-VIII are drawn to different compositions or products. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions of groups VI-VIII are all drawn to different products or compositions which differ from each other structurally and functionally. Thus, restriction between the groups is proper .

6. Inventions of groups I-III and group VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product or the system of group VI can be used in different inventions of groups I-III. Thus, restriction between the groups is proper.

7. Inventions of group V and groups VI, VII are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the

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process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)).

In the instant case the inventions of group V can be used to make the system of group VI and the composition of group VII. The composition of group VII is different from the group VI system..

8. Inventions of groups I-IV and group VIII are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)).

In the instant case the composition of group VIII can be prepared using any one method from groups I-IV. Thus, restriction between the groups is proper.

9. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

10. This application contains claims directed to the following patentably distinct species of the claimed invention:

A) if group I is elected, applicants are requested to elect a single species of the following:

i) reporter molecule;

ii) detectable activity;

iii) first panel of molecules;

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iv) second panel of molecules;

v) library of molecules

B) if group II is elected, applicants are requested to a single species of the following:

I) first panel of molecules;

ii) second panel of molecules;

iii) first fragment of reporter molecule;

iv) second fragment of reporter molecule;

v) activity;

vi) library of molecules.

C) if group III is elected, applicants are requested to elect a single species of the following:

I) first fragment of reporter molecule;

ii) second set of reporter molecule;

iii) different panel members;

iv) reporter molecule activity.

D) if group V is elected, applicants are requested to elect a single species of the following:

I) first panel of molecules;

ii) second panel of molecule;

iii) reporter molecule.

The species claimed are structurally and functionally different from each other, thus species election is proper.

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Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 117 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CAR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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11. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CAR 1.143).

12. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CAR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CAR 1.48(b) and by the fee required under 37 CAR 1.17(I).

13. Applicant is required to reply to this restriction requirement within 30 days of mailing this action. See MPEP 809.2(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Ponnaluri whose telephone number is (703) 305-3884. The examiner is on ***Increased Flex Schedule*** and can normally be reached on Monday to Friday from 7.00 AM to 3.30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsna Venkat, Ph.D., can be reached on (703) 308-2439. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

P. Ponnaluri
Patent Examiner
Technology Center 1600
Art Unit 1627
12 July 2002


PADMASHIRI PONNALURI
PRIMARY EXAMINER



RESTRICTION ELECTION FACSIMILE TRANSMISSION

DATE:

FROM/ATTORNEY:

FIRM:

PAGES, INCLUDING COVERSHEET:

PHONE NUMBER:

TO EXAMINER: P. Ponnaluri

ART UNIT: 1627

SERIAL NUMBER: 09/603,885

FAX/TELECOPIER NUMBER: (703) 308-4315

**PLEASE NOTE: THIS FACSIMILE NUMBER IS TO BE USED ONLY
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COMMENTS: _____

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